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Paper No. 4

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AUG 29 2002

In re Application of
Moran et al.
Application No. 10/091,072
Filed: March 5, 2002
Attorney Docket Number: 476-2098

OFFICE OF PETITIONS
DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR §1.47(a), filed June 11, 2002.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on March 5, 2002, with a partially executed oath or declaration and naming Thomas Moran, James Harkin, Neil O'Connor, Paul Enright and Thomas Macnamara as co-inventors.

A petition and petition fee to acquire rule 47 status was filed on June 11, 2002.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and, (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) as set forth above.

As to item (1), it is not clear in the documents presented whether Rule 47 applicant maintains inventor Enright can not be reached or that Enright refuses to sign the oath or declaration. If it is applicants' contention Enright cannot be reached, applicant must demonstrate diligent efforts were made to find or reach non-signing inventor. See MPEP 409.03(d). Did rule 47 applicant contact known colleagues for a forwarding address of inventor Enright? Was an electronic search conducted to locate the last known address? Did rule 47 applicant look in the phone book for a listing of inventor Enright? Did rule 47 applicant contact former employer Nortel Networks to determine if there was an emergency contact from which forwarding information can be gathered?

The statements made in the petition do not illustrate "diligent effort" was made to locate inventor Enright. Furthermore, the fact that inventor Enright may be traveling does not

present a situation where rule 47 status is granted.¹

Applicant should present copies of documentary evidence that support a finding that the non-signing inventor could not be found or reached and the steps taken to locate the non-signing inventor. If applicant provides sufficient evidence that diligent effort has been made to locate the inventor and inventor can not be located, 47 applicant is not required to send a copy of the application. Rule 47 applicant failed to show or provide sufficient proof the inventor can not be reached.

If applicant desires to make the case that the non-signing inventor refuses to execute the oath or declaration, applicant will need to establish a copy of the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventor and he refused to sign. The facts presented in the petition indicate application papers may have been delivered via Cosignia, however there has not been verification of the delivery. If it can be established that the application papers were delivered to the last known address of inventor Enright and there has been no response to the application papers, this may be construed as a refusal by the inventor to execute the application papers. However, rule 47 applicant must give the non-signing inventor an opportunity to sign the oath or declaration by sending the application papers to the last known address of the inventor. If applicant is aware the non-signing inventor can not be reached at the address provided on the declaration, applicant should make a showing that diligent effort has been made to locate the inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. See MPEP 409.03(b).